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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,521	06/29/2001	Jennifer O. Yiu	3399P049	8176

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2686

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,521

Applicant(s)

YIU ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 4, 16-18, 21, 26, 28, 29, 36-39 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Havinis et al (US 6,311,069).

Regarding claims 1, 16, 21 and 26, Havinis teaches a method of dynamically controlling release of information on a network (see Abstract), the method comprising: determining that protected information associated with a hand-held wireless communication device is needed or requested by a remote network entity (see column 3, line 56 to column 4, line 2 and see column 5, line 41 to column 6, line 22), and enabling a user of the hand-held wireless communication device to dynamically control release of the protected information based on a result of said determining (see column 7, lines 50-67).

Regarding claims 3, 17 and 28, Havinis further teaches the protected information comprises presence information relating to the hand-held wireless communication device (column 7, lines 50-60 see "position request").

Regarding claims 4, 18 and 29, Havinis further teaches the information

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comprises location information relating to the hand-held wireless communication device (column 7, lines 50-60 see "position request").

Regarding claims 36 and 37, Havinis further teaches the determining that protected information associated with a remote (see column 1, lines 8-12), hand-held wireless communication device is needed by another network entity comprises intercepting a request to the network entity from the hand-held wireless communication device (see column 2, lines 28-41 and see column 7, lines 50-67. In addition, Applicant's specification page 9, line 22 discloses "another network entity is an origin server").

Regarding claim 38, Havinis teaches the determining that protected information associated with a remote, hand-held wireless communication device is needed by another network entity comprises receiving a communication from the network entity (see fig.1, wireless connection between MS 20 and BST 24), wherein the communication from the network entity is responsive to a request from the hand-held wireless communication device to the network entity (see column 1, lines 8-12 and see column 2, lines 28-41. In addition, Applicant's specification page 9, line 22 discloses "another network entity is an origin server").

Regarding claims 39 and 42, Havinis teaches a method of dynamically controlling release of information on a network (see abstract), the method comprising: receiving a communication from a remote application on a wired network (see column 3, line 56 to column 4, line 2), the communication responsive to a prior request sent by a hand-held wireless client device on a wireless network to the remote server (see fig.5, wireless

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connection between mobile station 20 and BTS 27b), determining, in response to the communication, that information associated with the hand-held wireless client device is needed to fulfill the request (see column 6, lines 13-22), communicating with the hand-held wireless client device to allow a user of the wireless device to dynamically control release of the information (also see column 7, lines 50-67), and releasing the information to the remote application according to a result of said communicating (also see column 7, lines 50-67).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 2, 27, 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Dent (US 6,571,212).

Regarding claims 2, 27, 40 and 43, Havinis teaches a method as recited in claim 1. Havinis does not specifically disclose the enabling comprises using Hypertext Transport Protocol (HTTP) to communicate with the wireless device.

Dent teaches the enabling comprises using Hypertext Transport Protocol (HTTP) to communicate with the wireless device (see column 17, lines 13-17 and column 10, lines 7-9).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Dent into the system Havinis in order to provide secure protocols for IP voice network (see Dent, column 10, lines 7-9).

6. Claims 5, 19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Schroderus et al (US 5,907,804).

Regarding claims 5, 19 and 30, Havinis teaches a method as recited in claim 1. Havinis does not specifically disclose the protected information comprises information identifying the hand-held wireless communication device or its user.

Schroderus teaches the protected information comprises information identifying the hand-held wireless communication device or its user (see column 5, lines 13-27).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Schroderus into the

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system Havinis in order to protect the identity of mobile equipment from unauthorized users.

7. Claims 6-8, 10-12, 14, 15, 20, 22-24, 31-35, 41, 44-52 and 54-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Raith (US 6,687,504).

Regarding claim 6, Havinis teaches claim 1. Havinis does not specifically disclose the remote network entity is a remote web-based application implemented on a wired network.

Raith teaches the remote network entity is a remote web-based application implemented on a wired network (see Raith, column 5, lines 10-21, column 5, line 66 to column 6, line 2).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Raith into the system Havinis so that location information can be accessed through the Internet.

Regarding claims 7 and 8, the combination of Havanis and Raith further teaches the enabling comprises presenting a user interface on the hand-held wireless communication device to enable the user to select from a plurality of options relating to release of the information (see Raith, column 4, lines 55 to column 5, lines 10).

Regarding claim 10, 15, 22, 45 and 56, Havinis teaches hand-held wireless communication device (see fig.4, mobile station 20) comprising: a processor (see fig.4, mobile station 20, the mobile station 20 inherently includes a processor), a transceiver

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to communicate with a remote device over a wireless medium (see fig.5, wireless connection between mobile station 20 and BTS 24b), an input control (see fig.4, mobile station 20 with keypad, and see column 6, lines 13-22), an output device (see fig.4, mobile station 20 with screen).

Havinis does not specifically disclose a memory storing instructions which configure the processor to generate a user interface on the output device to enable a user to use the input control to dynamically control release of information associated with the hand-held wireless communication device to a remote application.

Raith teaches a memory storing instructions which configure the processor to generate a user interface on the output device to enable a user to use the input control to dynamically control release of information associated with the hand-held wireless communication device to a remote application (see column 3, lines 9-34).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Raith into the system Havinis so that the release of the location information can be controlled by the user.

Regarding claims 11, 23 and 46, Havinis further teaches the protected information comprises presence information relating to the hand-held wireless communication device (column 7, lines 50-60 see "position request").

Regarding claims 12, 24 and 47, Havinis further teaches the information comprises location information relating to the hand-held wireless communication device (column 7, lines 50-60 see "position request").

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Regarding claims 14, 20, 34 and 51, the combination of Havanis and Raith teaches the remote network entity is a remote web-based application implemented on a wired network (see Raith, column 5, lines 10-21, column 5, line 66 to column 6, line 2 and see fig.2).

Regarding claims 31, 33, 48 and 50, the combination of Havanis and Raith further teaches operating as a proxy between the hand hand-held wireless communication device and remote applications (see Raith, fig.2, gateway 206).

Regarding claims 32, 49 and 57, the combination of Havanis and Raith further teaches providing a gateway to interface a wireless network on which the hand hand-held wireless communication device operates with a wired network (see Raith, fig.2, gateway 206).

Regarding claims 35, 41, 44, 52 and 58, the combination of Havanis and Raith further teaches the enabling comprises presenting a user interface on the hand-held wireless communication device to enable the user to select from a plurality of options relating to release of the information (see Raith, column 4, lines 55 to column 5, lines 10).

Regarding claims 54, 59 and 60, Havanis further teaches determining that protected information associated with a remote (see column 1, lines 8-12), hand-held wireless communication device is needed by another network entity comprises receiving a request for said information from the network entity (see column 2, lines 28-41 and see column 7, lines 50-67. In addition, Applicant's specification page 9, line 22 discloses "another network entity is an origin server").

Regarding claims 55 and 61, A method as recited in claim 26, wherein said determining that protected information associated with a remote, hand-held wireless communication device is needed by another network entity comprises receiving a communication from the network entity (see fig.1, wireless connection between MS 20 and BST 24), wherein the communication from the network entity is responsive to a request from the hand-held wireless communication device to the network entity (see column 1, lines 8-12 and see column 2, lines 28-41. In addition, Applicant's specification page 9, line 22 discloses "another network entity is an origin server").

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Raith (US 6,687,504) and further in view of Dent (US 6,571,212).

Regarding claim 9, the combination of Havinis and Raith teaches a method as recited in claim 8. The combination of Havinis and Raith does not specifically disclose the enabling comprises using Hypertext Transport Protocol (HTTP) to communicate with the wireless device.

Dent teaches the enabling comprises using Hypertext Transport Protocol (HTTP) to communicate with the wireless device (see column 17, lines 13-17 and column 10, lines 7-9).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Dent into the system

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Havinis and Raith in order to provide secure protocols for IP voice network (see Dent, column 10, lines 7-9).

9. Claims 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Raith (US 6,687,504) and further in view of Schroderus et al (US 5,907,804).

Regarding claims 13 and 25, the combination of Havinis and Raith teaches a method as recited in claims 10 and 22. The combination of Havinis and Raith does not specifically disclose the protected information comprises information identifying the hand-held wireless communication device or its user.

Schroderus teaches the protected information comprises information identifying the hand-held wireless communication device or its user (see column 5, lines 13-27).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Schroderus into the system Havinis and Raith in order to protect the identity of mobile equipment from unauthorized users.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Meadows (US 6,716,101).

b. Ishii (US 5,740,539).

c. Hagebarth (US 6,687,505).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

CLH
06/13/04

Charles Appiah
CHARLES APPIAH
PRIMARY EXAMINER